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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,901	03/31/2004	Georges Harik	7171.P024	9296

7590 01/05/2009
Blakely, Sokoloff, Taylor & Zafman LLP
John P. Ward
12400 Wilshire Boulevard
Seventh Floor
Loas Angeles, CA 90025

EXAMINER

MAUNG, ZARNI

ART UNIT	PAPER NUMBER
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2451

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01/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,901	Applicant(s) HARIK ET AL.	
	Examiner ZARNI MAUNG	Art Unit 2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This action is responsive to the amendment and remarks filed on October 22, 2008. Claims 1-49 are presented for further examination.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-12, 20-29, 30-38, 41-49 are drawn to an instant messaging (1M) system comprising:

an IM server connected to a communication network; and
logic operable on the IM server enabling a first user to browse contacts associated with a second user, wherein the logic enables the second user to act as an intermediary in response to a request by the first user to add a contact associated with the second user, classified in **Class 709, subclass 206**.

II. Claims 13-19, and 39-40 are drawn to an instant messaging (IM) system comprising:

a repository storing profile information about individual users; and a description-based search means executable by users to search the profile information stored in the repository for one or more other users based on search criteria entered by a searching user, the one or more other users being new contacts to the searching user, classified in **Class 707, subclass 3**.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I is directed to logic operable on the IM server enabling a first user to browse contacts associated with a second user,

wherein the logic enables the second user to act as an intermediary in response to a request by the first user to add a contact associated with the second user, classified in different **Classes/subclasses**. And, this combination, Invention I, as claimed does not require the particulars of the subcombination as claimed because the Invention I does not explicitly require a description-based search means executable by users to search the profile information stored in the repository for one or more other users based on search criteria entered by a searching user, the one or more other users being new contacts to the searching user. **More specifically, Invention I does not require search means executable by users to search the profile information stored in the repository for one or more other users based on search criteria entered by a searching user.** The subcombination has separate utility such as start, stop and interrupting the simulation executed by the simulation execution means at the specified timing, classified in a different Class/Subclass. See M.P.E.P. § 806.05(d).

These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-12, 20-29, 30-38, 41-49) would require use of search **Class 709, subclass 206** (not require for the invention II).

(b) the Group II search (claims 13-19, and 39-40) would require use of search **Class 707, subclasses 3** (not require for the invention I).

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made **with or without traverse**. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 2451

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zarni Maung whose telephone number is (571) 272-3939. The Examiner can normally be reached on Monday-Friday from 8:30 to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, John Follansbee can be reached at (571) 272-3964. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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Faxed to the Central Fax Office:
(571) 273-8300 (New Central Fax No.)
Or Telephone
(571) 272-2100 for TC 2100 Customer Service Office.

/Zarni Maung/

Primary Examiner, Art Unit 2451